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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,537	08/28/2000	Eric Mahr	Q59776	7787

7590 12/13/2004
Sughrue Mion Zinn MacPeak & Seas PLLC
2100 Pennsylvania Avenue N W
Washington, DC 20037-3213

EXAMINER

JUNG, MIN

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,537

Applicant(s)

MAHR, ERIC

Examiner

Min Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7, 8, 14, 15, 17-22, 24, 25 and 34-40 is/are allowed.
- 6) ☒ Claim(s) 6, 9-13, 16, 23 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 9, 16, 23, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6, 16, 23, 28, it is not clear whether the meaning of "message origination (MO) message" and "message origination (MO)" correspond to that of "mobile originated (MO) message" taught in the specification. Clarification is required.

In claim 9, the preamble states the method as "a method for sending----", but the body of claim is directed to method for receiving. Clarification is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 26-30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lohtia et al., 6,560,456 (Lohtia).

Lohtia discloses system and method for providing subscriber-initiated information over the short message service (SMS) or a microbrowser.

Regarding claim 26, Lohtia teaches originating a short message from a mobile station for transmission in the wireless communication network (mobile user requests a preselected data, for example, by sending a SMS message, col. 7, lines 24-26, lines 59-67) while the mobile station maintains an active session with an information server (It is inherent that the user requests can be made while the mobile station is in active session with the information server, for example, web server 314. Microbrowser makes it possible to choose and/or flip-flop between different requests). See col. 6, lines 36-52, and col. 7, lines 17-42.

Regarding claims 27 and 30, Lohtia teaches Wireless Application Protocol (WAP) as one of the protocols to be used in operating the system disclosed. Therefore, WAP server and WAP session are inherent within the teaching.

Regarding claim 28, Lohtia teaches mobile originated message. See col. 7, lines 24-26, and lines 59-67.

Regarding claim 29, Lohtia teaches the short message being displayed in the display of the mobile station (Fig. 2, step 209, and Fig. 4, step 406), the message is controlled according to information received from the information server in that the received information mandates what is displayed. See col. 7, lines 12-15, and col. 10, lines 7-15.

Regarding claim 32, Lohtia specifically teaches at least IS-41 network, and suggest different possibilities as well. See col. 7, lines 43-54.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lohtia.

Regarding claim 31, Lohtia fails to specifically teach receiving a message termination message. However, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the method of Lohtia by sending an additional message notifying the message termination to the mobile terminal because such obvious step has been commonly in use in the field of communication.

Regarding claim 33, Lohtia further fails to specifically teach any of the formats including Wireless Markup Language (WML), Handheld Device Markup Language

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(HDML), and Compressed Hypertext Markup Language (CHTML). Text information transmitted to a wireless device would need to be formatted in a meaningful way so as to be used properly. Therefore, the system would have to be implemented using one of the formats known in today's wireless technology. Lohtia teaches wireless devices adapted to receive text information in data communication environment, and therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to adopt of the WML, HDML, or CHTML as a formatting tool to carry out a meaningful communication between the wireless device and the data network.

Response to Arguments

7. Applicant's arguments with respect to claims 26-33 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

8. Claims 1-5, 7-8, 14-15, 17-22, 24-25 and 34-40 are allowed.

9. Claims 6, 16, and 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 9-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The La Fleur patent, the Zenith patent, the Carey et al. patent, the Sandgren patent, the McDowell et al. patent application publication are cited for further references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127. The examiner can normally be reached on Monday, Tuesday, and Thursday 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
December 9, 2004


Min Jung
Primary Examiner